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JUN 9 1948
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1947

No. 809

GENERAL TIME INSTRUMENTS CORPORATION,
Petitioner,

vs.

THE UNITED STATES TIME CORPORATION,
Respondent.

REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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We present this reply brief because the brief of the respondent distorts completely the issues decided by the judgment which this Court is asked to review. The respondent, in its brief, attempts to make it appear that the majority of the Court of Appeals for the Second Circuit ruled adversely to petitioner on contested issues of fact and held that the design of petitioner's clock is not "distinctive", and that the resemblance of respondent's clock to petitioner's clock is not such as to deceive an ordinary purchaser. The Court of Appeals made no such rulings. Petitioner accepted the findings of the District Court, on the issues of fact presented, and, in its appeal, urged that the District Court was in error in its application of the law to the facts as found. The questions presented to the Court of Appeals were solely questions of law, and only such questions are presented here.

In its findings, the District Court compared, element by element, the various features making up the complete clocks sold by petitioner and respondent, respectively, as indicated in the parallel columns appearing on pages 2 and 3 of respondent's brief. The District Court then ruled that the respondent had appropriated the essential features of petitioner's clock design (Finding 14, R. 79), and, also concluded that, were plaintiff's design patent valid, it would be infringed by respondent's clock (Conclusion 2, R. 80).

As pointed out in our brief accompanying the petition, the test of infringement of a design patent, established years ago by this Court in *Gorham Company* v. *White*, 14 Wall. 511, 528, and uniformly adhered to ever since, is whether the accused design so resembles the patented design as to deceive an ordinary purchaser into purchasing one article "supposing it to be the other". The majority of the Court of Appeals for the Second Circuit accepted the District Court's rulings on questions of fact, without independent comment. Judge Frank, in his dissenting opinion, accepted the District Court's holding on the similarity of the two clocks, and added his own views as to the close resemblance of the two articles.

We submit, therefore, that the judgment for which review is sought by this petition is based on the finding of fact that the resemblance of the two clocks is such as to deceive the ordinary purchaser so that he is likely to buy one clock "supposing it to be the other".

The respondent's contention that the majority of the Court of Appeals for the Second Circuit held that the petitioner's design was not distinctive, is based entirely on a confusion of the issues of patentable novelty and unfair trade. The District Court, in its decision on patentability over the prior art, compared the petitioner's design with the various clocks of by-gone years presented by defendant in support of its defense of invalidity. The District Court's

ruling of invalidity in view of the prior art was affirmed by the Court of Appeals, and no review of that ruling is sought. This prior art is not pertinent to the question of whether or not the design of petitioner's clock is distinctive in the market where unfair competition is charged, as there is no evidence that these prior art clocks were in that market. Had the issue of the validity of plaintiff's patent and the issue of unfair competition been separately tried, these prior art clocks would not be before the Court at all.

The Court did not find, nor has respondent asserted, that any one of these prior art clocks, upon which the District Court relied for its holding of invalidity, was on the market at any time subsequent to the introduction in 1939 of the petitioner's new Big Ben clock. So far as that market is concerned the design of petitioner's clock was unquestionably "distinctive". The word "distinctive" in itself includes the object and its surroundings. An individual in the native dress of China would present a distinctive appearance on Fifth Avenue, but, in Canton, would not be distinguishable from his fellows.

The respondent, in its statement, on page 2, of its brief of the "Questions Presented," does not recite the issues which were decided by the Court of Appeals. Question "1," as drafted by respondent, implies that petitioner is seeking a review of a fact issue by this Court. To the contrary, petitioner asserts that the District Court, and all members of the Court of Appeals, found that the design of respondent's clock was deceptively similar to the design of petitioner's clock.

Respondent's statement of Question "2" is absurd on its face. Certainly mere adoption and use of a design, or trade-mark, does not create for it a "secondary meaning". It is the continuous, extensive and exclusive use for a period of years that gives to a design or mark the significance of a "secondary meaning".

It is petitioner's position that proof of such continuous, extensive and exclusive use for a period of years, without more, is sufficient to establish in the user a proprietary right in the design so used, and that the adoption and use by a competitor of a deceptively similar design should be enjoined, without proof of specific instances of "palming off".

CONCLUSION

These are important questions of law which have not been, but should be, decided by this Court and petitioner prays that the writ be granted.

Respectfully submitted,

W. Brown Morton,
Counsel for Petitioner.

New York, N. Y.,
June 7, 1948.